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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,443	12/09/2004	Yusuke Shimizu	05905-0179	8650
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER	
			WONG, JEFFREY KEITH	
			ART UNIT	PAPER NUMBER
			3718	
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			01/18/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,443

Applicant(s)

SHIMIZU ET AL.

Examiner

JEFFREY K. WONG

Art Unit

3718

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 24, 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This Office-Action acknowledges the Amendment filed on 10/15/2010 and is a response to said Amendment.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoy, US Patent 6,896,618(Benoy) in view of Hansen et al., US 7,455,590 (Hansen). Regarding Claims 18, 24, and 26.

Benoy teaches a game system including an arcade game machine installed in a play facility with which a player plays a game after paying a play fee (Col 1, lines 20-34. Casino games require a player to pay a fee to play), and a server device connected to the arcade game machine via a network (Abstract. The loyalty program server is connected to the gaming machine), the game system being configured to perform: registering identification information unique to the player on the server device (Abstract. Players must enter identification information before playing a game); allowing the player to play the game on the arcade game machine when the identification information transmitted from the player meets the identification information stored on the server(Col

8, 1-3. Players will be able to play the game and accumulate loyalty points after validating their identification), wherein the arcade game machine includes an interface for recording the identification information of the player, and authenticates the identification information registered on the server device (Col 2, lines 25-35. In this case, it is obvious that the gaming machine would require an interface in order to allow players to register for a tracking account for use with a cardless tracking system):

Benoy fails to disclose:

after the registering, allowing the player to store on the server device an optional message in advance in association with the registered identification information and in association with an event associated with a game result of the game to be played, which is designated by the player who expects the event to occur during a progress of the game to be played before allowing the player to start the game on the arcade game machine, said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player, transmitting the optional message from the server device to the terminal device optionally designated in advance by the player so that the optional message is displayed on the terminal device when the event has occurred on the arcade game machine during the progress of the game after starting the game, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player.

However, Hansen discloses of a system in which registered players can send messages in response to events occurring on a gaming service (Abstract) which allows

players to communicate with one another from within a gaming environment as well from without (Col 3, lines 5-20). Players are able to register their consoles which give them the ability to participate in multiplayer games within a gaming community (Col 1, lines 47-65). After a player has registered, the player can choose to be alerted by email message or by a message that is received on a mobile communication device such as cell phone (Col 2, lines 57-65) on events that occur in the gaming environment that would be of interest to the player such as a friend being connected to the gaming service (Col 2, lines 47-57). One form of communication a player can send it in the form of a message to a friend in which the friend will receive the message when a predefined event occurs, such as when the friend logs on to the gaming environment (Col 3, lines 36-55 and Col 10, lines 47-60). When the message is to be displayed to the player expected to receive the message, said message can be displayed in a plurality of ways such as that of an email or a pop up window (Col 3, lines 36-45).

This is viewed as encompassing the limitations described above because players are able to send messages in advance that are associated with a game result. In this case, such messages are sent based on the game in which a player connects. When a player logs into a game, this is viewed as being associated with the game result after the game has been played in response to input from the player. This is because the act of selecting the game in which to log in is a form of player input and the game result of logging in is the game being accessed for play.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the messaging system of Hansen's

teachings with Benoy's invention because it would allow players to communicate with one another from within the same gaming environment as well as from without as taught by Hansen.

Regrading Claim 25.

Hansen teaches wherein said optional message contains plural messages which are stored in relation with certain game stages or statuses as said event designation in advance by the player, respectively

(Col 10, line 61 to Col 11, line 24. In this case, players are alerted on the status of their games such as when a new version of the game comes out.)

Regarding Claim 27.

Benoy teaches wherein said designated terminal device is the arcade game machine on which the player plays the game (Abstract. Players play at the designated machine in which said player enters identification information.).

Regarding Claim 28.

Benoy teaches wherein said designated terminal device is either another arcade game machine on which an opponent player plays the game or a mobile terminal device which the opponent player carries (Col 5, lines 26-28).

Regarding Claim 29.

Benoy teaches wherein said designated terminal device is the one of the plurality of game apparatuses on which the player plays the game (Col 4, line 22).

Regarding Claim 30, 31.

Benoy teaches wherein said designated terminal device is either another of the plurality of game apparatuses on which an opponent player plays the game or a mobile terminal device which the opponent player carries (Col 5, lines 26-28).

Regarding Claims 32, 33.

Benoy teaches a game system comprising a server (abstract) and a plurality of game apparatuses (Col 4, line 22) connected via a network (Col 5, lines 56-57), which is configured to allow one player to play a game on one of the plurality of game apparatuses against another player playing on another of the plurality of game apparatuses (Col 4, lines 54-64. Bingo is played against another player), said game system being configured to perform:

registering identification information unique to each player (Abstract. Players must input identification information) so that the one player on the one of the plurality of game apparatuses can play the game against the another player on the another of the plurality of game apparatuses, wherein the game system includes an interface for recording the identification information of the player, and authenticates the identification information registered on the server (Col 2, lines 25-35. In this case, it is obvious that

the gaming machine would require an interface in order to allow players to register for a tracking account for use with a cardless tracking system):

Benoy fails to disclose:

allowing the one player to store on the server an optional message in advance by way of a mobile terminal device operated by the one player, said optional message being a message arbitrarily prepared or designated by the one player, stored on the server in relation to the registered identification information and in relation to an event associated with a game result of the game to be played, which the one player expects to occur during a progress or as a result of the game, and arranged to be displayed on a terminal device designated in advance by the player; wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player; transmitting the optional message to said designated terminal device from the server so that the message is displayed on the designated terminal device when the event designated in advance by the one player has occurred during a progress or as a result of the game after starting the game, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player.

However, Hansen discloses of a system in which registered players can send messages in response to events occurring on a gaming service (Abstract) which allows players to communicate with one another from within a gaming environment as well

from without (Col 3, lines 5-20). Players are able to register their consoles which give them the ability to participate in multiplayer games within a gaming community (Col 1, lines 47-65). After a player has registered, the player can choose to be alerted by email message or by a message that is received on a mobile communication device such as cell phone (Col 2, lines 57-65) on events that occur in the gaming environment that would be of interest to the player such as a friend being connected to the gaming service (Col 2, lines 47-57). One form of communication a player can send it in the form of a message to a friend in which the friend will receive the message when a predefined event occurs, such as when the friend logs on to the gaming environment (Col 3, lines 36-55 and Col 10, lines 47-60). When the message is to be displayed to the player expected to receive the message, said message can be displayed in a plurality of ways such as that of an email or a pop up window (Col 3, lines 36-45).

This is viewed as encompassing the limitations described above because players are able to send messages in advance that are associated with a game result. In this case, such messages are sent based on the game in which a player connects. When a player logs into a game, this is viewed as being associated with the game result after the game has been played in response to input from the player. This is because the act of selecting the game in which to log in is a form of player input and the game result of logging in is the game being accessed for play.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the messaging system of Hansen's teachings with Benoy's invention because it would allow players to communicate with

one another from within the same gaming environment as well as from without as taught by Hansen.

Regarding Claim 34.

Hansen teaches wherein the optional message is displayed on arcade game machines of other game players playing the same game (Col 10, lines 47-60. When a plurality of players have the same friend on their friend list, and when said friend logs on to the gaming environment, the message would be displayed on their respective display.)

Response to Arguments

3. Applicant's arguments with respect to claims 18, 24, 26-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
5. Ota et al. US 6,702,676, Message creating game machine and message creating method therefor.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY K. WONG whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 9:30am-8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/
Primary Examiner, Art Unit 3718

JKW